



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,352	06/14/2000	Erik J. Johnson	10559/226001/P8791	8251

20985 7590 08/28/2003
FISH & RICHARDSON, PC
4350 LA JOLLA VILLAGE DRIVE
SUITE 500
SAN DIEGO, CA 92122

EXAMINER

LIM, KRISNA

ART UNIT PAPER NUMBER

2153

DATE MAILED: 08/28/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

3

Office Action Summary

Application N .

09/594,352

Applicant(s)

JOHNSON ET AL.

Examiner

Krisna Lim

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-14 and 19-22 is/are rejected.
- 7) ☒ Claim(s) 15-18 and 23-26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 2153

1. Claims 1-30 are presented for examination.
2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
 - I. Claims 1-10, drawn an article comprising a computer-readable medium and a method, comprising the steps of: a) receiving a data packet; b) evaluating the data packet; and c) delivering the control information from a network processor to an OS by way of non-invasive driver if present, classified in Class 370, subclass 355.
 - II. Claims 11-26, drawn to an article comprising a computer-readable medium and a method, comprising the steps of: a) instantiating a driver to a communicate between an OS and a network processor; b) registering the driver with the OS; and c) registering the driver with the network processor, classified in Class 717, subclass 174.
 - III. Claims 27-30, drawn to a driver comprising: a) an operating system interface; and b) a network processor interface, classified in Class 717, subclass 120.
3. Inventions **I and II** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that **(1)** the combination as claimed does not require the particulars of the subcombination as claimed for patentability, **and (2)** that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the Invention **I does not require** the step of: a) instantiating a driver to a communicate between an OS and a network processor; b) registering the driver with the OS; and c) registering the driver with the network processor. The subcombination has separate utility such as an article

Art Unit: 2153

comprising a computer-readable medium and a method **lacks of** the steps of: a) receiving a data packet; b) evaluating the data packet; and c) delivering the control information from a network processor to an OS by way of non-invasive driver if present.

4. Inventions **I and III** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that **(1)** the combination as claimed does not require the particulars of the subcombination as claimed for patentability, **and (2)** that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the Invention **I does not require** a driver comprising: a) an operating system interface; and b) a network processor interface. The subcombination has separate utility such as an article comprising a computer-readable medium and a method **lacks of** the steps of: a) receiving a data packet; b) evaluating the data packet; and c) delivering the control information from a network processor to an OS by way of non-invasive driver if present.

5. Inventions **II and III** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that **(1)** the combination as claimed does not require the particulars of the subcombination as claimed for patentability, **and (2)** that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the Invention **II does not require** a driver comprising: a) an operating system interface; and b) a network processor interface. The subcombination has separate utility such as an article comprising a computer-readable medium and a method **lacks of** the steps of: a) instantiating a driver to a communicate between an OS and a network processor; b) registering the driver with the OS; and c) registering the driver with the network processor.

Art Unit: 2153

6. These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose.

7. For example, the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) the Group I search (claims 1-10) would require use of search class 370, subclass 355 (which would not required for the groups II and III).

(b) the Group II search (claims 11-26) would require use of search class 717, subclass 174 (which would not required for the groups I and III).

c) the Group III search (claims 27-30) would require use of search class 717, subclass 120 (which would not required for the groups I and III).

8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

9. During a telephone conversation with Mr. Scott C. Harris on August 19, 2003 a provisional election was made without traverse to prosecute the invention of Group II, claims 11-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-10 and 27-30 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

10. The title of the invention is neither descriptive nor precise. A new title is required which should include, using twenty words or fewer, claimed features that differentiate the invention from the Prior Art. The title should reflect the gist of or the improvement of the present invention.

Art Unit: 2153

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 11-14 and 19-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. [U.S. Patent No. 5,586,268] in view of Beal et al. [U.S. Patent No. 5,872,956].

13. Chen et al. disclosed (e.g., see Figs. 1, 7-8) the invention substantially as claimed. Taking claims 11 and 19 as exemplary claims, the reference disclosed a method, comprising the step of instantiating (e.g., see col. 1 (lines 21-23, 57-58), col. 2 (lines 55-57), col. 2, line 67 to col. 3, line 12) a driver (104 of Fig. 7) to communicate between an operating system (102 of Fig. 7) and a network processor (102 of Fig. 1 or a hardware computer peripheral adapters), . Chen et al. however did not explicitly detail the steps of registering the driver with either the OS or the network processor. Beal et al. on the other hand taught such feature of registering the driver with the OS and with the network processor (e.g., see col. 11, lines 7-10).

14. Chen et al. disclosed a multiple peripheral adapter device driver for efficiently handling of potentially **multiple peripheral interface adapters through a single instantiation of a device driver in an OS** and Beal et al. disclosed **device drivers that can support various operating systems network protocols and adapter hardware**. Efficiently handling multiple interface adapters through a single instantiation of a device driver in an OS and having a device drivers that can support various operating systems network protocols and adapter hardware would have been desirable

Art Unit: 2153

features in the art at the time the invention was made. Thus, it would have been obvious to one having an ordinary skill in the art to combine the teaching of these two references so that the desirable features can be achieved as suggested by the references since they all are directed to the same art (device driver).

15. As to claims 12 and 20, Beal disclosed the driver (125) appears to the OS as a network interface device driver (e.g., see col. 3, line 65, Fig. 5 (Items 403, 405, 411, 413, 415), Fig. 6 (items 503 to 513), col. 4, line 66, to col. 5, line 11).

16. As to claims 13 and 21, Beal disclosed the driver (125) appears to the network processors as a forward interface (e.g., see Fig. 1 (items 107, 109 and 120), col. 4, line 66, to col. 5, line 11).

17. As to claims 14 and 22, Beal disclosed the driver (125) corresponding to a forward interface between a network (Fig. 1) and the network processor (101 of Fig. 1) (e.g., see Figs. 1 and 7, col. 4, line 66, to col. 5, line 11).

18. Claims 15-18 and 23-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the

Art Unit: 2153

period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Krisna Lim whose telephone number is (703) 305-9672. The examiner can normally be reached on Monday-Friday from 7:00 to 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Glenton Burgess, can be reached at (703) 305-4772. The fax phone numbers for the organization where this application or proceeding is assigned is as following:

(703) 746-4481 [Direct fax number]
(703) 746-7238 [After Final Communication]

or

(703) 746-7239 [Official Communication]
(703) 746-7240 [For Status inquiries, draft communication]

and/or

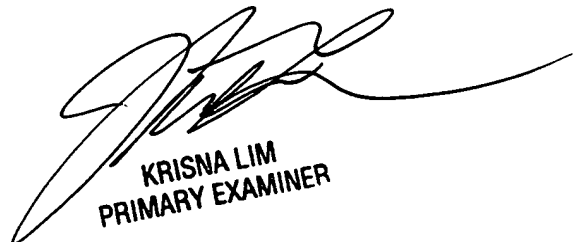
(703) 306-5631, (703) 306-5632 or (703) 306-5633 for [Customer Service Numbers]

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

All Internet e-mail communication will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirement of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Office Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

kl

August 23, 2003



KRISNA LIM
PRIMARY EXAMINER